



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,472	01/06/2004	Ki-Bong Sung	P69408US0	2341
43569	7590	10/26/2005	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			YUN, JURIE	
			ART UNIT	PAPER NUMBER
			2882	

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

86

Office Action Summary	Application No. 10/751,472	Applicant(s) SUNG ET AL.	
	Examiner Jurie Yun	Art Unit 2882	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 8/16/05 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicants have disclosed only a mechanical switch which is not by itself capable of performing the claimed functions without associated logic circuitry which has not been taught. The means for performing the various remote control operations are not taught. For example, the means to turn the collimator on/off, the means to switch to remote control mode after the triple click step, etc., are not taught. It is assumed that what is being claimed is more than just a switch.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. It is not understood what is meant by "the collimator is turned on" and "an X-ray unit is performed".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makrinos et al. (USPN 5,206,894).

8. With respect to claims 1 and 2, Makrinos et al. disclose a remote control handswitch (12) for a portable X-ray unit (14), comprising: a switch (16) formed of a standby and execution button; a handswitch housing (19) having the switch on an upper side of the same, wherein a multi-function operation is performed based on a click operation of the switch (column 4, lines 43-60), wherein the remote control handswitch further includes a remote controller. Makrinos et al. do not disclose the switch is a two-step switch. However, the switch operates like a two-step switch in that it performs different functions depending on how many times the switch is pushed or clicked (column 4, lines 43-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a two-step switch in place of the switch used by Makrinos et al., because a two-step switch is easier to use/click.

Response to Arguments

9. Applicant's arguments filed 8/16/05 have been fully considered but they are not persuasive. Regarding the 35 U.S.C. 112, first paragraph rejection, applicants argue that the features of the claims that are not enabled should be pointed out, and that the

Art Unit: 2882

specific circuitry involved in making an LED blink is known in the art. However, this is not claimed in claim 1, for example. There is nothing which recites an LED blinking. The applicants have disclosed only a mechanical switch which is not by itself capable of performing the claimed functions without associated logic circuitry which has not been taught. The means for performing the various remote control operations are not taught. For example, the means to turn the collimator on/off, the means to switch to remote control mode after the triple click step, etc., are not taught. It is assumed that what is being claimed is more than just a switch.

It is noted that applicants have not addressed the 35 U.S.C. 112, second paragraph rejection at all. It is not understood what is meant by "the collimator is turned on" and "an X-ray unit is performed".

Applicants argue that Makrinos teaches away from the click operation recited in claim 1, and that Makrinos indicates that devices with multiple electromechanical switches require the continuous activation of a plurality of electrical switches to prepare the rotating anode X-ray tube and create a radiographic exposure, and that in these types of switches, the electromechanical switch mechanisms often jam. However, what is being claimed is a two-step switch, which does not require continuous activation of a plurality of electrical switches. What is required in claim 1 is a multi-function operation being performed based on a click operation of the two-step switch. Makrinos teaches use of one button, but the button operates similar to a two-step switch in that it performs different functions depending on how many times the switch is pushed or clicked (column 4, lines 43-60). It would have been obvious to one of ordinary skill in the art at

Art Unit: 2882

the time the invention was made to use a two-step switch in place of the switch used by Makrinos et al., because a two-step switch is easier to use/click.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jurie Yun whose telephone number is 571 272-2497. The examiner can normally be reached on Monday-Friday 8:30-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Glick can be reached on 571 272-2490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2882

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jurie Yun
October 17, 2005



Craig E. Church
Primary Examiner